

# **Intellectual Property Policy for Loyola Marymount University**

**Approved by the Board of Trustees**

**December 1, 2008**

## LMU Intellectual Property Policy

### Introduction

Loyola Marymount University (LMU or University) is committed to providing an atmosphere that is conducive to excellence in teaching, scholarship, research and creative activity. Faculty, staff and students are encouraged to engage in the scholarly pursuit of knowledge, artistic production, and both basic and applied research. Though not a primary University goal, the results of such pursuits sometimes lead to the development of Intellectual Property that may be copyrighted, patented, or otherwise have commercial value. The University has interest in protecting this Intellectual Property for several reasons. Through promoting the disclosure, dissemination, and utilization of Intellectual Property, the University and Members of the LMU Community support the public good. In addition, the creation and development of Intellectual Property provide professional benefits to the individuals involved, contribute to the intellectual life of the University, and may provide monetary benefits to the Inventors and to the University. With this in mind, LMU seeks to provide an environment in which creative efforts and innovations are encouraged and rewarded.

With the adoption of this policy, LMU articulates the principles and processes to guide decision-making related to the ownership of Intellectual Property. This policy covers all forms of Intellectual Property created at or under the auspices of the University, including but not limited to those covered by copyrights and patents. The purpose of this policy is to clarify for Members of the LMU Community their collective rights and responsibilities regarding Intellectual Property. This policy also describes the ways in which the University's faculty, staff and students can protect the Intellectual Property that they create, both for their benefit as well as to preserve the interests of the University.

This policy is established with the understanding that it may be augmented by statements of policy or practice focused on particular types of Intellectual Property, especially those arising out of new or evolving media or technology. Further, this policy itself may be amended over time to effect changes deemed to be in the best interest of the University community.

Absent a signed agreement to the contrary, this Intellectual Property Policy is deemed to be a part of the conditions of employment of every employee of the University, including student employees, and of the conditions of enrollment and attendance by every student at the University.

### Definitions

**Courseware:** Courseware includes course syllabi, the expressive content of digital teaching media, CD-ROMs, DVDs, courses delivered by television, video, internet or

other media or technologies not yet developed, Web publications, and any other materials created for the purpose of teaching or instruction or to support the teaching of a course.

**Exceptional Contribution of University resources:** An Exceptional Contribution of University resources is a contribution of University resources beyond what is ordinarily available and specifically provided to Members of the LMU Community in a given area to carry out their duties. Unless otherwise provided in writing, none of the following would constitute an Exceptional Contribution for faculty members: normal use of offices, office computers, libraries, secretarial services, photocopying, software that is readily available to all faculty (e.g., Blackboard) and other types of resources, property and personnel that are readily and regularly available to faculty in a specific program, department or school.

**Intellectual Property:** Creations of the mind or intellect, the ownership of which is recognized and protected by law now or in the future. Intellectual Property includes copyrightable subject matter, any patentable invention, tangible research property, trademarks, trade secrets, works of art and inventions or creations that might normally be developed on a proprietary basis.

**Invention:** Any new or useful discovery, process, machine, manufacture, or composition of matter, or any new and useful improvement thereof. Inventions are novel, useful, and not obvious to individuals skilled in the field in which they are developed.

**Inventor:** An individual who contributes to the conception of the Invention. In this context, conception is the formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is to be applied in practice. Individuals—including students—who help to test or perform work with the conception of another are not Inventors. However, anyone—including a student—who contributes to the conception of the Invention must be recognized as a co-Inventor.

**Members of the LMU Community:** any employee or enrolled student of Loyola Marymount University.

**Sponsored Project:** An externally funded activity governed by a written agreement between LMU and the sponsor. Sponsored project agreements typically involve grants, contracts, cooperative agreements or letters of agreement.

### **Intellectual Property Advisory Committee**

The Provost, in consultation with the Chief Academic Officer and the Deans, shall establish LMU's Intellectual Property Advisory Committee. At least half of the committee members shall be LMU tenured or tenure-track faculty members chosen in consultation with the LMU Faculty Senate. It shall be the function of this committee to advise the Chief Academic Officer and the Provost with respect to:

1. Guidelines and procedures for the implementation of this Policy and the processes for reviewing and assessing the technical merit and market potential of potential commercial applications.
2. Proposed amendments to this Policy.
3. Such other matters pertaining to this Policy or its application as the Provost may deem appropriate.

### **Ownership of Material Subject to Copyright Protection**

The policies articulated in this section apply to all forms of copyrightable material, with the exception of courseware which is covered in a separate section.

#### **Works Created by Faculty**

Subject to the exceptions noted below and in keeping with longstanding academic tradition, ownership of pedagogical, scholarly, artistic and creative works resides with the faculty creator. This includes such things as scholarly articles and books, novels, plays, musical creations, works of art, films and textbooks. The only exceptions to faculty ownership of such works are as follows:

1. **Sponsored Project:** When copyrightable material is created by a faculty member using funding from a Sponsored Project, the terms of that Sponsored Project will supercede this general policy with regard to ownership. Ideally, the terms of any such Sponsored Project should be specified clearly and prior to the work being undertaken or produced.
2. **Works commissioned at the request of the University:** When a faculty member is commissioned by the University to perform a specific task with a defined outcome that includes copyrightable material, said work shall be considered a Work-for-Hire and shall be wholly-owned by the University. For example, if the University commissions a faculty member to write a history of LMU's first 100 years, the University would own the resulting work. Unless a particular copyrightable work is specifically commissioned by the University, ownership remains with the faculty creator even though the faculty member may have been supported by sabbatical or other internal grant during the time the work was undertaken.
3. **University use of material:** The University may display, copy and distribute works of faculty-developed material, including copyrightable material, for University use without payment of royalties or other fees to the faculty member. Should a faculty member separate from the University, the University shall retain these rights without payment of royalties or other fees to the faculty member.

### **Works Created by Non-Faculty Employees**

Subject to the exceptions noted below, any work created in the course of one's duties as an employee (including a student employee) who is not a faculty member will be considered a Work-for-Hire and wholly owned by the University. The exceptions to University ownership of such works are as follows:

1. **Sponsored Project:** When copyrightable material is created by a non-faculty employee using funding from a Sponsored Project, the terms of that Sponsored Project will supercede this general policy with regard to ownership. Ideally, the terms of any such Sponsored Project should be specified clearly and prior to the work being undertaken or produced.
2. **Student employees assisting a faculty member:** Work created by a student employee in the course of being directed by a faculty member to assist in that faculty member's scholarly work shall be considered a Work-for Hire for the faculty supervisor. Ownership of such work resides with the faculty supervisor, subject to the exceptions noted in the section "Works Created by Faculty."
3. **Scholarly writings:** Scholarly writings (for example, articles and books) that are authored by a non-faculty employee will be wholly owned by the employee.

### **Works Created by Students Other Than in the Course of Employment**

1. A copyrightable work created by a student other than in the course of employment by the University is wholly-owned by the student, subject to the terms of any applicable Sponsored Project.
2. The student right of ownership is limited to the underlying fixed work of authorship created by the student and does not extend to the data or other scholarly information that the student may have collected, obtained or used during a project, research or other work.
3. The University may display, copy and distribute works of student-developed material for internal university use without payment of royalties or other fees to the student.

### **Ownership of Courseware**

The policies articulated in this section apply to all forms of courseware.

#### **Courseware Created by Faculty**

Subject to the exceptions noted below, ownership of courseware resides with the faculty creator. The only exceptions to faculty ownership of courseware are as follows:

1. **Sponsored Project:** When courseware is created by a faculty member using funding from a Sponsored Project, the terms of that Sponsored Project will supercede this general policy with regard to ownership. Ideally, the terms of any such Sponsored Project should be specified clearly and prior to the work being undertaken or produced.
2. **Courseware commissioned at the request of the University:** When a faculty member is commissioned by the University to create specific courseware for use by the University, said work shall be considered a Work-for-Hire and shall be wholly-owned by the University.
3. **Exceptional Contribution of University resources:** When courseware is developed with an Exceptional Contribution of University resources, ownership of said courseware is negotiable, as long as said courseware was not commissioned by the University or created using funding from a Sponsored Project. Whether a particular instance of courseware has been developed with an Exceptional Contribution of University resources is determined by the Provost in consultation with the Chief Academic Officer and the Intellectual Property Advisory Committee. Once it has been determined that there has been an Exceptional Contribution of University resources, ownership is determined by the Provost after consultation with the Chief Academic Officer and the Intellectual Property Advisory committee. For purposes of this courseware policy, sabbaticals and internal grants would not, in and of themselves, be considered an Exceptional Contribution of University resources unless there is written agreement to the contrary between the faculty member and the University.
4. **University use of courseware:** Faculty who develop courseware will not be entitled to charge the University a fee for using their author-owned courseware in their teaching at the University. If the author leaves the University, the University shall have the right, without cost or payment to the author, to use, reproduce, adapt, modify, update, exhibit and display all courseware created during the period of employment for a period of three years after conclusion of the author's employment at LMU. The University's right to the use of author-owned courseware does not prevent the author from using said courseware elsewhere or from otherwise exercising the rights associated with ownership.

### **Courseware Created by Non-Faculty Employees**

Courseware created in the course of one's duties as an employee (including a student employee) who is not a faculty member will be considered a Work-for-Hire and wholly owned by the University with the following exception:

1. **Sponsored Project:** When courseware is created by a non-faculty employee using funding from a Sponsored Project, the terms of that Sponsored Project will supercede this general policy with regard to ownership. Ideally, the terms of any such Sponsored Project should be specified clearly and prior to the work being undertaken or produced.

## Patents

### Ownership of Inventions

LMU is the owner of all patentable discoveries or Inventions made or conceived by faculty members and other University employees (including student employees) in the course of their responsibilities to the University or with an Exceptional Contribution of University Resources. Provisions of this policy include the following.

1. Anyone conducting research at the University that could result in patentable Inventions is required to sign an Invention Agreement (see Appendix A).
2. All potentially patentable Inventions conceived or reduced to practice by Members of the LMU Community during the course of their responsibilities to the University or developed with an Exceptional Contribution of University resources shall be disclosed on a timely basis to the University. Instructions for disclosing potentially patentable Inventions are provided in Appendix B.
3. Whether a particular Invention has been developed with an Exceptional Contribution of University Resources is determined by the Provost after consultation with the Chief Academic Officer and the Intellectual Property Advisory Committee.
4. When a potentially patentable Invention has been developed using funding from a Sponsored Project, the terms of that Sponsored Project will supercede this general policy with regard to ownership. Ideally, the terms of any such Sponsored Project should be specified clearly and prior to the work being undertaken or produced.
5. The University shall share royalties from Inventions owned by or assigned to the University with the Inventor according to the schedule that appears later in this policy.
6. If the University elects not to pursue the patenting and commercialization of a disclosed Invention, and elects not to pursue other means of attaining University benefit and encouraging public use and benefit of a disclosed Invention, it may assign ownership to the Inventor(s) pursuant to the provisions of this policy set forth in the section "Pursuing a Patent."
7. In cases where the University elects to pursue the patenting and commercialization of a disclosed Invention, or elects other means of attaining University benefit and encouraging public use and benefit of a disclosed Invention, the Inventor(s) may nonetheless petition the Provost to assign ownership to the Inventor(s). The grant or denial of such a petition is at the discretion of the Provost who will consult with the Chief Academic Officer and the Intellectual Property Advisory Committee. The standard to be applied is whether assignment from the University to the Inventor(s) is in the best interest of the University. An appropriate case for such an assignment may be one where the University has been unsuccessful for a substantial period of time in its attempts to patent, license, commercialize, or otherwise encourage significant public use of the Invention.
8. A patentable discovery or Invention made or conceived by a student other than in the course of employment by the University and without an Exceptional

Contribution of University Resources is wholly-owned by the student, subject to the terms of any applicable Sponsored Project.

Waivers of the provisions of this policy may be granted by the Provost after consultation with the Chief Academic Officer and the Intellectual Property Advisory Committee. Only written waivers signed by the Provost shall be valid and enforceable waivers of this policy.

### **Publication and Patent Rights**

Because patents exclude others from using inventive methods or materials for a defined period of time, they provide opportunities for Inventions to be commercialized. Commercialization provides opportunities for the general public to benefit from the Invention and remuneration to accrue to the Inventors and other interested parties. Because of the potential value inherent in a patent, establishing ownership is a legally defined process that requires Inventors to adhere to specific steps.

To protect an Invention's potential value as it is being developed, Inventors are advised to:

1. Establish the date of Invention through maintaining bound notebooks recording the development of the Invention on signed and dated numbered pages that are witnessed. Signed and dated entries also should be maintained if further efforts are made to reduce the Invention to practice.
2. Members of the LMU community are encouraged to publish research results and scholarly information in a timely manner. At the same time, Inventors should be aware that publication of an idea embodied in an Invention or any other non-confidential disclosure, such as abstracts, websites and posters, bars the filing of a patent application in many countries. In the United States, the Inventor has one year to file from the date of publication. For these reasons, publication has important implications, particularly if the Inventor and the University desire to commercialize the Invention. For these reasons, Inventors are encouraged to disclose their Inventions prior to publication (see Appendix B) to help ensure that patentability is not compromised. (Inventors should note that describing an Invention in a federal grant application constitutes publication and compromises patentability if the grant is awarded because funded applications are publicly available through the Freedom of Information Act. With this in mind, when submitting a grant application Inventors should identify any section of an application that contains confidential and/or proprietary information in order to protect an Invention.)
3. Inventors should exercise care in discussing an Invention with other individuals so as not to compromise the ability to patent or otherwise protect ownership of the Invention. It is particularly important to obtain non-disclosure agreements before discussing an Invention with potential commercial partners. Inventors should

retain all non-disclosure agreements in a secure place and provide copies to the University upon request.

### **Pursuing a Patent**

Obtaining a patent for an Invention is a costly and time-consuming process. Because of this, the University must be prudent when determining whether or not to pursue a patent for an Invention.

Once ownership by the University has been established in accord with this policy document, the Provost will consult with the Chief Academic Officer and the Intellectual Property Advisory Committee and appoint an ad hoc committee to recommend whether or not the University should pursue a patent. It is anticipated that the ad hoc committee may include faculty members or other Members of the LMU Community who have the necessary expertise to provide an independent evaluation of the Invention. In addition to information provided by the Inventor(s), the ad hoc committee may rely upon information provided by other sources qualified to evaluate the Invention, including outside consultants and technology development firms. The ad hoc committee will play an advisory role, making a recommendation to the Provost, with whom final decision-making authority will rest.

In cases where the University elects to pursue the patenting of a disclosed Invention, the Provost, after consultation with the Chief Academic Officer and the Intellectual property Advisory Committee, may assign the University's ownership rights to a commercial venture or other interest that has the resources to patent and commercialize the Invention as well as to protect the intellectual property from any legal challenges. In appropriate cases, where it is in the best interest of the University and after consultation with the Chief Academic Officer and the Intellectual property Advisory Committee, the Provost may choose other means of encouraging public use and benefit of a disclosed Invention.

If the University elects not to pursue the patenting and commercialization of a disclosed Invention, and elects not to pursue other means of attaining University benefit and encouraging public use and benefit of a disclosed Invention, it may assign ownership to the Inventor(s). In such cases, it is the policy of the University to notify the Inventor(s) of its decision regarding whether or not to pursue the Invention within four months of the date the Provost receives the disclosure form. In such cases the Inventor(s) may pursue patenting and commercialization using private resources. In applying this part of the policy the University recognizes that Inventors may sometimes make untimely Invention disclosures, leaving less than four months from disclosure to when a patent application must be filed to preserve an Assignee's or Inventor's right to patent. While the University is not responsible for any loss of right to patent that might follow from the application of any of the provisions of this policy, when the University is given specific notice that the loss of right to patent is imminent it is the policy of the University to try to take reasonable steps to preserve an Inventor's right to patent in cases where the University decides not to pursue an Invention. Such steps may include notifying an

Inventor of a University decision not to pursue a patent in fewer than four months of the date the Provost receives the disclosure form.

Unless other terms are specified in writing, when the University assigns ownership of a disclosed Invention to the Inventor(s) the University retains a non-exclusive, royalty-free license to the Invention.

### **Distribution of Financial Benefit and Expense**

The expense of any patent application or proceeding for an Invention owned by the University will be paid by the University or its assignee. The University reserves the right to enter into a written agreement with a party of its own choosing to share the costs of a patent application and related proceedings.

Prior to the distribution of any royalties or other income, all direct expenses related to prosecuting and maintaining a patent and commercializing the Invention, including attorney's fees, shall be reimbursed to the University from receipts related to the Invention. Upon request, the University will provide a list of these receipts to the Inventor(s).

The resulting net income will be distributed according to the following schedule.

- 50 percent to the Inventor(s) or his/her assignee
- 30 percent to the University
- 20 percent to the Inventor(s)' college or school

## Appendix A

### Loyola Marymount University Invention Agreement

In consideration of my employment by Loyola Marymount University (hereinafter referred to as "LMU"), the availability to me of opportunities to perform research including sponsored research, and/or to utilize resources of LMU, I agree:

1. That any patentable invention or discovery which is conceived or first reduced to practice in the course of my employment with LMU (including but not limited to the performance of a grant, contract or award made to LMU by any extramural agency), or with an Exceptional Contribution of LMU resources, shall belong to LMU, and be subject to the provisions of LMU's Intellectual Property Policy (approved December 1, 2008); and
2. To disclose promptly in writing to LMU through the Office of Research and Sponsored Projects any such discovery or invention and identify by date any publication, sale, public use or manuscript submission related thereto; and
3. To assign all rights to such discoveries or inventions and any and all patents and patent applications thereon to LMU, or such other agency as LMU may direct, and to cooperate fully with LMU or such designee in the prosecution of patents or patent applications and the preparation and execution of all documents necessary or incidental thereto.

Signed: \_\_\_\_\_  
(To include first name in full)

Printed Name: \_\_\_\_\_

Title: \_\_\_\_\_

Department: \_\_\_\_\_

Date Signed: \_\_\_\_\_

## Appendix B

### Loyola Marymount University

#### Invention Disclosure Procedure

One important objective of Loyola Marymount University's business is gathering and disseminating knowledge. The process of recognizing when an invention exists and subsequently making it available for use by and/or in the service of the public is one way of accomplishing this objective. The University, therefore, encourages the inventive process and will, within the limits of its judgment and committed financial resources, provide needed advice and assistance to further this activity.

An invention should normally be disclosed when it has been demonstrated to work but, in special circumstances (e.g., past or imminent public disclosure, competition, anticipated delay in reducing to practice, extensive analysis or modeling, etc.), disclosure can be made upon conception. The generally accepted rule of thumb, which is to *disclose first and publish later*, is followed to prevent the potentially costly result that can occur with premature publication. Such activity can have negative legal, financial, and tactical consequences in any effort to commercialize the invention. For this reason, it is highly recommended that inventions be disclosed as soon as it is clearly conceptualized rather than waiting until it is reduced to practice. Any information supplied with an initial disclosure to the University should be supplemented by further details as they become known to the inventor. Details about the required disclosure of all inventions are contained in the University's **Intellectual Property Policy**.

The University has resources available to it that will assist in determining whether an invention is actually patentable, what rights inure to a sponsor or sponsor(s) of an invention, and in resolving other legal issues. Complete LMU's **Invention Disclosure Form** to document all known details about the invention as soon as practicable and forward to the Vice President for Research. If unsure whether or not an invention exists, contact the Executive Director of LMU's Office for Research and Sponsored Projects (extension 86004).

**Loyola Marymount University****Invention Disclosure Form**

*Forward this completed and signed form to LMU's Vice President for Research.*

1. Brief Descriptive Title of the Invention

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2. Inventor(s): name; position; department; and phone. (Identify all individuals who have made significant intellectual contributions to this invention's advance over prior technology, but do not include anyone merely because s/he has carried out some of the experimental work.)

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3. Specify any other inventor(s) who is/ are an employee or an organization other than LMU, and the institutional affiliation.

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4. Background (To successfully determine the patentability of this invention, it will be necessary to compare it to existing technology, referred to as "prior art." Provide any references to assist in this evaluation.)

- A. If possible, identify any references to the prior art by patent number or journal article identification.

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- B. Specify any deficiency in the prior art improved upon by this invention or any limitation which it extends.

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5. Briefly describe the invention (use additional sheets, as necessary). Indicate specifically what is considered to be the invention, as distinct from the prior art. The description may be by reference to another document, which should be attached to this disclosure (e.g., copy of a report, preprint, excerpt from a proposal, etc.). Also attach any sketches, flow charts, structural formulas, circuit diagrams, etc. that are appropriate to and necessary for full disclosure. Please identify any such attachment(s) positively by having each page signed, dated, and witnessed.

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6. Conception is the recognition that a novel arrangement of structural elements, composition of matter, manner of implementing a process, etc. will produce a useful result. Does there exist an earlier, dated record of the invention's conception (e.g., a sketch, report, laboratory notebook entry, etc.) that describes this invention and can be independently corroborated? Please indicate what it is and where it is.

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7. Indicate the first successful reduction to practice of this invention (date, place, record, witnesses).

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8. Has this invention been disclosed to others, either verbally or in written form (date, place, to whom, method of disclosure)?

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9. Indicate any pending disclosures (date, place, to whom, method of disclosure).
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10. List patents, publications, and/or commercial products or processes known to you showing a.) technology closest to this invention, and b.) closest known use of those elements or steps of this invention that differ from a.).
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11. Indicate the potential commercial use of this invention (e.g., fields of use, advantages, estimate of value).
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12. Indicate any potential commercial licensees that may be interested in this invention.
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13. Identify any sponsors and projects (provide fund number) under which either conception or first reduction to practice occurred, including partial funding and Federal "formula" funding. Also list any related projects and/or inventions and any other potential claimants to rights in this invention.
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14. Were any University funds or other resources used in making this invention (if yes, please explain).



**Departmental Endorsement:** To the best of my knowledge, the above information is correct.

\_\_\_\_\_  
Department Head Signature

\_\_\_\_\_  
Date

**Advisor Endorsement for Inventions by LMU Students:** To the best of my knowledge, the above information is correct.

\_\_\_\_\_  
Student Advisor Signature

\_\_\_\_\_  
Date

**For LMU's Vice President for Research Use Only**

Date Received \_\_\_\_\_ Acknowledged by \_\_\_\_\_

Sponsorship Rights Verified: Yes \_\_\_\_\_ No \_\_\_\_\_

Copies Attached: Yes \_\_\_\_\_ No \_\_\_\_\_